

**MICHAEL BEST
& FRIEDRICH**
Attorneys at Law

www.mbf-law.com

Michael Best & Friedrich LLP
Madison Office
One South Pinckney Street
P.O. Box 1806
Madison, WI 53701-1806
Telephone (608) 257-3501
FAX (608) 283-2275**FACSIMILE TRANSMISSION****DATE:** April 24, 2002**To:**

NAME	FAX NO.	PHONE NO.
Joseph T. Woitach, Examiner USPTO	703-746-5192	703-305-3732

FROM: Jill A. Fahrlander**PHONE:** (608) 283-0124**SENT BY:** Leslie L.**EXTENSION:** 7516**LOCATION:** 9th Floor**RE:** US Pat App SN 09/463,276

NUMBER OF PAGES, INCLUDING COVER:	2		
CLIENT MATTER NUMBER:	096429-9085	SENDER'S ACCOUNT NUMBER:	836

NOTES/COMMENTS:

Page 5 of the Amendment filed January 3, 2002, in response to the Office Action (paper 8) mailed October 3, 2001, follows.

THE INFORMATION CONTAINED IN THIS FACSIMILE IS INTENDED ONLY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENTS NAMED ABOVE. THIS MESSAGE MAY BE AN ATTORNEY-CLIENT COMMUNICATION, OR MAY BE PROPRIETARY CONFIDENTIAL INFORMATION OF A CLIENT, AND AS SUCH IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR ANY AGENT RESPONSIBLE FOR DELIVERING IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR, AND THAT ANY REVIEW, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.

IF YOU DO NOT RECEIVE ALL OF THE PAGES OR IF YOU EXPERIENCE FAX TRANSMISSION PROBLEMS, PLEASE CALL FAX DEPARTMENT AT (608) 257-3501, Ext. 7209 AS SOON AS POSSIBLE.

The aforementioned amendments were made for reasons unrelated to patentability to better clarify the claimed invention. Applicants respectfully request that the rejections under 35 U.S.C. 112, second paragraph be withdrawn.

Rejections under 35 U.S.C. 102(b)

Claims 12, 14, and 15 stand rejected as being anticipated by Gurdon (J. Cell Sci., 1986). The Examiner noted that the patentability of a product-by process claim is determined by the novelty and nonobviousness of the product. Claims 12, 14, and 15 are drawn to embryos made by the method of claim 1 (claim 12) or 13 (claim 14). Applicants note that claim 15 is a composition claim drawn to a nuclear transfer embryo comprising certain characteristics, and is not limited to an embryo made by the method of claim 1 or 13.

Barnes *et al.* is characterized as teaching the isolation and *in vitro* culturing of bovine embryos. Applicants respectfully submit that the Barnes *et al.* publication does not anticipate the embryo of claim 12, 14, or 15, because it fails to teach all of the claim limitations. Claim 12 is drawn to an embryo made by the method of claim 1. Barnes *et al.* does not teach an embryo comprising an oocyte of one species and a nucleus of a second species, as would an embryo made by the method of claim 1. Barnes *et al.* does not anticipate claim 14, which is drawn to an embryo made by the method of claim 13; an embryo made according to the method of claim 13 would comprise a non-bovine nucleus and the cytoplasm of the enucleated bovine recipient cell. Neither does Barnes *et al.* anticipate claim 15, which requires that the embryo comprise cytoplasm and cell membrane from one species and that the differentiated cytoplasm, differentiated cell membrane, and nucleus are derived from a differentiated cell of another species. In view of the foregoing, Applicants respectfully request that the rejection be withdrawn.

Gurdon is said to teach hybrid nuclear transplant embryos. Gurdon teaches nuclear transfer of one species to an enucleated oocyte of a second species. In each case, the recipient oocyte was from an amphibian, specifically, from the frog genus *Rana*, *Xenopus*, or *Pleurodeles*. An embryo according to claim 14, which is described in the preceding paragraph, is not anticipated by Gurdon, which fails to teach an embryo made by the method of claim 13, which would comprise bovine cytoplasm and a non-bovine nucleus. Claim 1, from which claim 12 depends, has been amended to clarify that the recipient oocyte is a mammalian oocyte. Gurdon does not explicitly teach all of the claim limitations of claim 15; therefore, the Examiner appears to be asserting that the embryos disclosed by Gurdon inherently possess the limitations of claim 15. Claim 15 has been amended to clarify that the embryo comprises cytoplasm and cell membrane from a first species, wherein the first